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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/038,590	03/26/93	KIM	A

EXAMINER	
MCCARTHY, N	

ART UNIT	PAPER NUMBER
1308	4

A3M1/0617

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DATE MAILED: 06/17/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☒ Notice re Patent Drawing, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 27-50 are pending in the application.
   Of the above, claims 27-43 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 44-50 are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 27-50 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 27-43, drawn to an upflow filter, classified in Class 210, subclass 274.

II. Claims 44-50, drawn to a method for backwashing a particulate bed filter, classified in Class 210, subclass 792.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (M.P.E.P. § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as a process wherein in both stages of backwashing, a combination of air and liquid are passed upwardly through the particulate bed filter.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art, as shown by their different classifications, restriction for examination purposes as indicated is proper.

During a telephone conversation with Applicants' representative, Mr. Faigus, on June 10, 1993 a provisional

election was made with traverse to prosecute the invention of group II, claims 44-50. Affirmation of this election must be made by applicant in responding to this Office action. Claims 27-43 have been withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Claims 44-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 5,080,808. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the instant application and the patent are both limited to backwashing of an upflow particulate bed filter wherein the filter is backwashed in the same direction as the influent which is filtered and the backwashing is done in a first stage with a combination of air and liquid at less than the minimum

fluidization velocity of the bed and the air flow rate is within the range of from 1 to 9 scfm/ft^2 and the effective size of the particles in the filter layer is greater than 1 mm and the specific gravity of the particles is in excess of 2.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Any inquiry concerning this communication should be directed to Neil M. McCarthy at telephone number (703) 308-3842.

Neil M. McCarthy
Examiner, Art Unit 1308

nmm
June 14, 1993